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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,619	10/07/2003	John Morgan	444/4	5544
27538	7590	04/18/2005	EXAMINER	
KAPLAN & GILMAN , L.L.P. 900 ROUTE 9 NORTH WOODBRIDGE, NJ 07095			CHEN, SOPHIA S	
			ART UNIT	PAPER NUMBER
			2852	

DATE MAILED: 04/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/680,619	MORGAN, JOHN	
	Examiner Sophia S. Chen	Art Unit 2852	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 01 February 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 11-16 is/are allowed.
- 6) Claim(s) 1,2 and 5-10 is/are rejected.
- 7) Claim(s) 3 and 4 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Objections

1. Claims 1 through 7 are objected to because of the following informalities:
 - a. Claim 1, line 4, "power" should be "powder".
 - b. Claim 10, line 1, "an surface" should be "a surface".

Appropriate correction is required.

Claim Rejections – 35 USC §102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Wang et al. (cited in previous Form PTO-892).

The patent discloses a recharged toner cartridge assembly comprises: a toner hopper 2 for containing recharged toner powder, the toner hopper 2 having a generally (emphasis added) flat upper surface with an opening 21 (Figure 8); a feed roller

compartment 1 for dispensing the toner powder, the feed roller compartment 1 having a generally (emphasis added) flat bottom surface with an opening 11 for engaging with the upper surface of the toner hopper 2; a sealing member 212 or 112 provided between the two flat surfaces for sealing around the openings 21, 11 when the two flat surfaces engage each other after recharging (column 12, lines 45-65; column 13, lines 13-15 and 60-63; Figure 8); wherein the sealing member 112 is adapted to be fixed to the bottom surface of the feed roller compartment 1 before the two flat surfaces engage each other (Figure 8); and the sealing member 112 is a flat sealing foam with a slot which matches the openings 11, 21 (column 13, lines 13-15 and Figure 8).

4. Claims 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Sugiyama et al. (cited in previous Form PTO-892).

Sugiyama et al. discloses a sealing member including a toner hopper 3 having a flat upper surface with an opening and a feed roller compartment 2 having a flat bottom surface with an opening (Figure 19), wherein the sealing member 5 is adapted to be fixed to the bottom surface of the feed roller compartment 2 before the feed roller compartment 2 engages with the toner hopper 3 (Figure 19); and the sealing member 5 is a flat sealing foam with a slot which matches the openings (Figure 19).

The examiner does not put any weight on the preamble because "to be used in a recharged toner cartridge assembly" is not part of the claimed limitation.

Claim Rejections – 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al. in view of Inoue (JP 08-278739 A).

Wang et al., as discussed above, differs from the instant claimed invention in not disclosing the sealing foam is fixed to the bottom surface of the feed roller compartment by a mechanical fixture, and the mechanical fixture is either a plurality of screws or a plurality of pin-hole connections.

Inoue discloses a sealing member 40 is fixed to a part 41 by a mechanical fixture, either a plurality of screws 41a (Figure 6) or a plurality of pin-hole connections 41a, 41b, 40c (Figures 1 and 7).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the mechanical fixture as taught by Inoue in place of the fixture of Wang et al. to easily remove sealing member from recycling parts without entailing a hike in costs (Inoue, abstract).

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sugiyama et al. in view of De Kesel et al. (US Pat. No. 6,760,556, cited in previous Form PTO-892)

Sugiyama et al., as discussed above, differs from the instant claimed invention in not disclosing the sealing foam has a surface provided with adhesive protected by a removable protective sheet.

Inoue discloses that an adhesive layer 4 is provided with a removable protective sheet 5 (column 12, lines 56-61).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the protective sheet as taught by Inoue to the sealing foam of Sugiyama et al. to prevent the sealing foam accidentally gluing to something else before gluing to the feed roller compartment.

Allowable Subject Matter

8. Claims 11-16 are allowed.
9. Claims 3 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
10. The following is a statement of reasons for the indication of allowable subject matter: Claim 11 is allowable over the prior art of record because the prior art of record does not teach or suggest a method of sealing a recharged toner cartridge assembly comprising the step of: after recharging (emphasis added) of toner powder to the toner hopper, engaging the feed roller compartment with the toner such that the sealing member is sandwiched between the two flat surfaces (emphasis added) around the opening, in combination with the remaining claimed limitations.

Other Prior Art

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Goebel et al. (US Pat. No. 6,014,534) discloses a toner cartridge comprising a layer of adhesive protected with a protective sheet.

Response to Arguments

12. Applicant's arguments filed 2/1/05 have been fully considered but they are not persuasive.

Page 6, lines 3-8 of the amendment filed 2/1/05, the applicant argues that Claims 8 and 11 recite the limitations "a toner hopper having a flat surface" and "a feed roller compartment having a flat surface." Sugiyama does not describe these limitations. The examiner does not agree with this argument. Since the preamble of claim 8, sealing member to be used in a recharged toner cartridge assembly, is not part of the claimed limitations, the Figure 19 of Sugiyama et al. does disclose the above limitations. See above 35 USC 102(b) rejection. Thus, claims 8 and 9 are anticipated by Sugiyama et al.

Page 7, lines 14-19 of the amendment filed 2/1/05, the applicant argues that Claim 1 recites the related limitation "when said two flat surfaces engage each other" referring to the engagement of the surfaces of the toner hopper and the feed roller compartment. Wang does not describe these limitations. This is not exactly correct. Claim 1 recites the surfaces of toner hopper and feed roller compartment are generally

(emphasis added) flat. Wang et al. does disclose these surfaces are generally (emphasis added) flat. See Figure 8 of Wang et al. and the above 35 USC 102(e) rejection. The examiner agrees that these surfaces are not totally flat, but they are generally flat.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sophia S. Chen whose telephone number is (571) 272-2133. The examiner can normally be reached on M-F (7:00-3:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Arthur Grimley can be reached on (571) 272-2136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sophia S. Chen
Primary Examiner
Art Unit 2852

Ssc
April 15, 2005